

Remarks

Applicants note with appreciation the withdrawal of rejections to claims 1, 4-15, 23, and 31-33 under 35 U.S.C. § 102(b) as being anticipated by Kumar et al. (Tetrahedron letters, 1991, 32(16):1901-1904). *See* for instance page 2 of the Office Action.

By this Amendment, independent claims 1 and 31 have been amended to incorporate all the limitations of claim 24. In addition, claims 6 and 25-30 have been amended to correct corresponding antecedent basis and to provide greater clarity. Support for these claim amendments can be found in the specification and the claims originally filed, and particularly in the original claim 24 now cancelled, and on page 30 of the original specification. No new matter is introduced by these claim amendments. Currently, claims 1, 4-23, and 25-37 are pending in the application.

As stated on pages 3-6 of the Office Action, the Examiner has newly rejected claims 1,4-15, 31-33, 35-37 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, with particular reference to the term "organic compound." As stated on page 6 of the Office Action, the Examiner has newly rejected claims 30-33 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting steps for producing the pharmaceutical compound from the product of the yeast mediated reaction. Additionally, and as stated on page 7 of the Office Action, the Examiner has newly objected to claims 24-29 as being dependent upon a rejected base claim, which would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

As amended and hence including all the limitations of claim 24, independent claim 1 along with claims 4-15 and 35-37 dependent therefrom and independent claim 31 along with claims 32-33 dependent therefrom are submitted to be allowable in view of the above-referenced Examiner's remarks in relation to claims 24-29. Applicants respectfully request the above-identified claim rejection under 35 U.S.C. § 112, first paragraph, be withdrawn and a Notice of Allowance be issued to that effect. Applicants respectfully request the restriction

requirement between the linked inventions be withdrawn in the event when the linking claim(s) becomes allowable.

With respect to rejections to claims 30-33 under 35 U.S.C. 112, second paragraph, independent claim 31 has been amended to recite a method of synthesizing an enantiomerically specific pharmaceutical compound, the method comprising subjecting an organic compound of Formula IV to a yeast-water paste of a yeast mediated reduction to form an enantiomerically specific precursor; and converting the enantiomerically specific precursor the enantiomerically specific pharmaceutical compound.

The invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. MPEP 2172 (I). *See also In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). A rejection based on the failure to satisfy the requirement under 35 U.S.C. 112, second paragraph, is appropriate *only* where applicant has stated, that the invention is something different from what is defined by the claims. *Id.* While a claim should not omit matter essential to the invention as described in the specification or in other statements of record, such matter is “essential” only if the matter has first been described by the applicant(s) as necessary to practice the invention. *See* MPEP 2172.01. Furthermore, what is conventional or well known to one of ordinary skill in the art need not be disclosed in detail.¹

Here, Applicants have set forth the claimed method in claim 31. Steps argued according to the Examiner as being missing from the independent claim 31, for instance, detailed steps involved in converting the precursor produced by the yeast mediated reaction to the pharmaceutical compound, need not to be recited in the claim(s) as these details are well within the skill and knowledge of the person in the art of the invention, particularly in view of footnote 1 cited hereinabove. *See* for instance page 30 of the original specification, at lines 9-12.

¹ *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94. *See also Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005). *See also* MPEP 2163II3(a).

Based on the above, withdrawal of rejections to claims 31-33 under 35 U.S.C. § 112, second paragraph, is respectfully solicited. Rejection to claim 30 under this subsection is believed to have been misplaced in view of the reasons provided by the Examiner, as claim 30 depends from claim 1 and does not recite a method of forming a pharmaceutical compound.

Conclusion

Applicants submit that the claims are in conditions for allowance and respectfully request a notice to that effect. If the Examiner believes that a telephonic conference will advance the prosecution of this application, such a conference is invited at the convenience of the Examiner.

Please charge any fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,

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